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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,814	05/21/2004	Kenzo Yokozeki	252308US0CONT	8845
22850 7590 06/01/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WALICKA, MALGORZATA A	
			ART UNIT 1652	PAPER NUMBER
			NOTIFICATION DATE 06/01/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/849,814	<b>Applicant(s)</b> YOKOZEKI ET AL.	
	<b>Examiner</b> Malgorzata A. Walicka	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6,8,9,11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,8,9,11 and 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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The examiner acknowledges The Amendment and Request for Reconsideration filed April 30, 2007. The finality of the Office action of Jan. 30, 2007 is withdrawn in favor of the action below.

Claim 1 has been amended; new claims 23-28 have been added. Claims 1, 6, 8-9, 11 and 13-28 are pending and under examination.

### **Detailed Action**

#### **Priority**

Acknowledgment is made of applicants' certified translation of priority document Japanese application JP 2002-218958, filed 07/26/2002. The priority of the instant claims to JP 2002-218958, filed 07/26/2002, has not been granted.

#### **Objections**

Objections to claims 1 and 8 made in the Office action of July 25, 2006 (previous action) are withdrawn, because the claims have been amended.

However, the claims are objected to for the following reasons.

- Claim 1      in lines 19, 23 and 28, 37 should have «the» instead of «an» before «amino acid» and «polynucleotide», respectively.
- Claim 6      in lines 3 and 4 should have «the» instead of «an» before «amino acid».
- Claim 8      in line 3 should have «the» instead of «an» before «amino acid».
- Claim 11     at the beginning of line 4 should have «the» instead of «an».
- Claim 13     at the beginning of line 4 should have «the» instead of «an».

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Claim 19 in line 3 should have «the» instead of «a» before «polynucleotide».

Claim 20 in line 6 please delete «that».

Claim 21 in line 3 should have «the» instead of «a» before «polynucleotide».

### **Rejections**

#### ***35 USC, section 112, second paragraph***

Claims 1, 6, and 8 and dependent claims 9, 11, 13-28 are rejected as reciting the limitation "one or to ten" which is confusing, because "one" belongs to the range of "to ten". Please limit the claim to "one to ten".

#### ***35 USC, section 112, first paragraph***

##### ***Lack of written description***

Rejections of claims 1 and claims 9 and 14 for lack of description of the structure of enzyme used in the claimed method is withdrawn because the claim 1 has been amended.

##### ***Scope of enablement***

Claims 1 and dependent claims 9, 11, 13, 14, 20, 22 and new claims 23, 24, 26 and 28 are rejected because the specification, while being enabling for a method of use of an enzyme encoded by the DNA molecule of SEQ ID NO: 11 encoding the enzyme of SEQ ID NO: 12, does not reasonably provide enablement for a DNA molecule that hybridizes under stringent conditions, which comprise hybridizing at 60 °C and 0.1 x

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SSC and 0.1% SDS, with a DNA molecule complementary to nucleotides 61-1917 or 121-1917 of SEQ ID NO: 11.

The conditions recited by the claims as stringent are recognized by one having skills in the art of medium stringency. Such conditions select DNA molecules having 80%- 90% identity, i.e., molecules with large modifications of the structure of sequences consisting of 61-1917 or 121-1917 of SEQ ID NO: 11. Accordingly, the invention as claimed requires from one having skills in the art an experimentation with a low probability of success, because it requires recruiting by hybridization an enormous number of DNA molecules, expressing them, testing their enzymatic activities and selecting those expressed proteins that retained the enzymatic activity. Without a further guidance, regarding the structural changes in SEQ ID NO: 11 that are neutral from the point of view of the function of the encoded polypeptide, the experimentation imposed on the skilled artisan is undue.

### **Conclusion**

Claims 1, 6, 8-9, 11, and 13-28 are rejected.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (571) 272-

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0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Malgorzata A. Walicka, Ph.D.  
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